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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,091		Kuriacose Joseph	2050.001US7	2849
44367	7590	02/02/2011		
SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938			EXAMINER BROWN, RUEBEN M	
			ART UNIT 2424	PAPER NUMBER
			NOTIFICATION DATE 02/02/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/903,091	<b>Applicant(s)</b> JOSEPH ET AL.	
	<b>Examiner</b> REUBEN M. BROWN	<b>Art Unit</b> 2424	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 246-249, 251, 254-258, 260-262, 265-273, 276-278, 280, 281, 284-292, 294-299 and 301-313 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/1/10</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 246-249,251,254-258,260-262,265-273,276-278,280,281,284-292,294-299 and 301-313.

## **DETAILED ACTION**

### **Response to Arguments**

1. Applicant's arguments with respect to claims, filed 9/1/2010 have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 312-313 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 312-313 set forth “machine readable storage medium.” However, the specification as originally filed does not explicitly define [the machine readable storage medium by stating that it ‘. . . includes, and is limited to’... ‘specific storage device(s)’.]

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow).

The broadest reasonable interpretation of a claim drawn to a [machine readable storage media] (also called computer readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is absent an explicit definition or is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory.

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The examiner recommends the following language:

1. Modifying “machine readable storage medium”, to be “machine readable non-transitory storage medium”.
2. Modifying “machine readable storage medium”, to be “machine readable storage device”.
3. Adding language, “...wherein the machine readable storage medium is not a signal”.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 246-249, 251, 254-258, 260-262, 265-273, 276-278, 280-281, 284-292 & 294-299 & 301-313 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romesburg, (U.S. Pat # 5,113,259), in view of Lappington, (U.S. Pat # 5,343,239).

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Considering claims 246, 247, 257, 268, 269, 277, 285, 286, 298 & 299, the claimed TV system or method comprising;

*'a client to receive data including at least auxiliary data & application data'*, Romesburg teaches a TV 100, which receives TV programming, as well as graphics and/or text, which reads on the claimed auxiliary data, col. 5, lines 1-10; Fig. 1.

*'a client computer to process computer code, included in the application data, to facilitate an interaction with a user'*; Romesburg teaches that the TV 100 includes a controller 410, which may be a microcomputer that contains a microprocessor and RAM 416 & ROM 414, see Fig. 4; col. 2, lines 64-68 thru col. 3, lines 1-12. However, Romesburg does not explicitly teach that the application data may include a computer code. Nevertheless Lappington, in the same field of endeavor of interactive programming, provides a disclosure of the TV/STB decoder 30 receiving interactive programming over the VBI of an incoming conventional video signal, see col. 4, lines 65-68 thru col. 5, lines 1-45; col. 6, lines 9-15. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Romesburg with the feature of transmitting computer executable code within the VBI of a TV signal, at least for the desirable benefit of using the bandwidth that is already available (i.e., an incoming TV channel), thus obviating the need to wait for the computer code to be downloaded separately from a different provider, as taught by Lappington, (Abstract; col. 1, lines 55-68; col. 2, lines 1-65 & col. 3, lines 17-51).

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It is noted that the STB/decoder 30 in Lappington (col. 6, lines 46-64) corresponds with TV 100 of Romesburg (col. 3, lines 1-12), both of which are client terminals that include a computer device, whereas the handheld terminal 28 of Lappington(col. 7, lines 1-36) corresponds with the external computer 110 of Romesburg, again both of which comprise local computers, collocated with the client terminal.

*'an auxiliary data processor to process the auxiliary data'*, reads on the VBI decoder in Lappington, col. 5, lines 6-15; col. 6, lines 45-64;

*'a display to display images based on at least one of the processed auxiliary data and the processed application data'*, is met by the monitor of the TV 100 of Romesburg, Fig. 1. Also the TV system of Lappington meets the limitation' col. 15, lines 50-68.

*'a local computer collocated with and in communication with the client to allow the client to communicate with the local computer...the local computer comprising a stand-alone computer system'*, the claimed subject matter is met by the external personal computer 110 of Romesburg that is connected to and communicates with the computer system of TV 100, see Fig. 1; col. 2, lines 10-55; col. 4, lines 3-61. Also, the handheld terminal 28 of Lappington is a local computer in communication with the client terminal, see Abstract; col. 16, lines 1-30.



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As for the further claimed feature, '*the local computer to control the client to process a computer program included in the received data*', see Romesburg, which teaches this limitation, Abstract; col. 4, lines 10-65, in that the external computer 110 controls the TV set 100 causing the TV set 100 to READ/WRITE video data to a mass storage device. Thus the limitation is met by the combination of Romesburg & Lappington, since Lappington provides the explicit teaching of a computer program, i.e., executable code being included in the received data that the local computer interacts with, and communicates with the client terminal, as recited in the claim.

As for the additionally claimed feature of a '*mass storage in communication with the local computer, wherein the client to enable the client is to retrieve information from the mass storage via the local computer*', Romesburg teaches that the TV 100 may retrieve video data from video RAM 480 under direction of local computer 110, (which reads on the claimed '*mass storage*') col. 2, lines 40-64; col. 3, lines 60-68 thru col. 4, lines 1-2; col. 4, ,lines 36-65.

Considering claims 248, 258, 270, 278, 287-288 & 301, Romesburg teaches that local computer 110 causes video data to be transferred/stored into video RAM 480, col. 3, lines 40-63; col. 4, lines 3-15.

Considering claims 249, 251, 260-262, 271-273, 280-281, 289-291 & 302-304, the local computer 110 (which is a PC) of Romesburg, controls the computer 410, within the TV 100, see col. 4.

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Considering claim 254-256, 265-267, 276, 284, 292, 294-297 & 305-311, the executable code reads on the interactive software sent in the VBI of Lappington, which is extracted from the TV signal by the STB/decoder 30 and then transmitted to the handheld terminal 28, see col. 11, lines 1-37; col. 12, lines 15-30; col. 16, lines 1-30. Romesburg goes on to disclose that the TV set 100 may store/retrieve/display text and/or graphics, see col. 5, lines 1-3, under the control of the external computer 110.

Considering claims 312-313, the claimed machine-readable medium embodying a sequence of instructions that, when executed by a machine, causes the machine to perform functions that correspond with subject matter mentioned above in the rejection of claim 246, is likewise analyzed. As for the claimed, '*machine*' the recitation reads on the CPU 412 used in the controller 410 of the TV set 100 of Romesburg.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Blakely Teaches a computer co-located with a client device that controls the instant client device.

B) Tindall Teaches a computer system co-located with a TV system, see Fig. 1.

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**Any response to this action should be mailed to:**

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**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

**Or:**

(571) 273-7290 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REUBEN M. BROWN whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Reuben M. Brown/  
Patent Examiner, Art Unit 2424